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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,588	03/29/2004	Valentino Montegrando	0424-07	3207

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LAW OFFICES OF ERIC KARICH  
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EXAMINER

NATNITHADHA, NAVIN

ART UNIT PAPER NUMBER

3736

DATE MAILED: 01/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/812,588

Applicant(s)

MONTEGRANDE ET AL.

Examiner

Navin Natnithithadha

Art Unit

3736

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Amendment*

1. Claim 3 has been amended. Claims 1, 2, and 4-9 have been cancelled. Claim 3 is pending.

### *Response to Arguments*

2. Applicant's arguments filed 04 November 2005 have been fully considered but they are not persuasive.

In the Remarks filed 04 November 2005, the Applicant states the following:

The head structure operates to penetrate and lockingly engage the wall of a blood vessel, enabling the function of the sensor. Since neither this structure nor an equivalent structure is shown in the Bullara reference, or the other prior art, Applicant respectfully submits that this amendment should place the application in condition of allowance.

However, the claimed structure must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). Bullara teaches the "probe" 68 includes a "neck portion" 118 that extends outwardly to a "head portion" 120 (see fig. 9). Claim 3 states "...being generally conical in shape to penetrate through and then lockingly engage the wall," which represents the functional limitation of the "head portion" element of the apparatus. In Bullara, the head portion

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120 is "generally conical in shape" and is **capable** of penetrating through and then lockingly engage the wall of the ventricles or chambers within the brain based on the shape/structure of the device shown in Figure 9. Therefore, claim 3 is anticipated by Bullara's device.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 3 is rejected under 35 U.S.C. 102(b) as being anticipated by Bullara, US 4,127,110 A.

Claim 3: Bullara teaches an "implanted sensor" (implantable pressure transducer) 10 (see figs. 6 and 7) intended for measuring pressure in a body cavity (see col. 2, lines 35-38), comprising:

a "main body" (housing) 83 having an "implant inductor" (inductor) 72;

a "probe" (transducer subassembly) 68 with a "capacitor" 75 "electronically connected to the "implant inductor" (see col. 6, lines 45-47), the "probe" 68 "adapted to fit through the wall" so that the "capacitor" 75 can sense pressure in the body cavity.

The function "for measuring pressure in a conduit through a wall" is a matter of intended use of the "implanted sensor" apparatus, in which Bullara's implantable pressure transducer 10 is capable of performing. Although Bullara teaches the implantable

pressure transducer 10 measures pressure in a body cavity, such as ventricles or chambers within the brain, Bullara additionally teaches "The transducer is also suitable for implantation elsewhere in the body or in other systems, and is believed useful in any application where a very small wireless device is needed to measure fluid or tissue pressure." (i.e. measuring pressure in a blood vessel).

Bullara teaches the "probe" 68 includes a "neck portion" 118 that extends outwardly to a "head portion" 120 (see fig. 9). Claim 3 states "...being generally conical in shape to penetrate through and then lockingly engage the wall," which represents the functional limitation of the "head portion" element of the apparatus. In Bullara, the head portion 120 is "generally conical in shape" and is **capable** of penetrating through and then lockingly engage the wall of the ventricles or chambers within the brain based on the shape/structure of the device shown in Figure 9.

Bullara teaches the "head portion" includes a "terminus" (not labeled) that forms an "aperture" (not labeled) that is covered with a "flexible membrane" 95 that defines an "internal chamber" (not labeled, space between bellows 77 and membrane 95) (see figs. 6 and 7).

Bullara teaches the "capacitor" 75 is operatively positioned adjacent the "internal chamber" (see fig. 6).

Bullara teaches the "internal chamber" is filled with "biocompatible fluid" (distilled water, a fluid compatible with the characteristics of the fluid being monitored, or Elliot's 'B' solution) (see col. 6, lines 25-29, and col. 7, lines 29-35).

**Conclusion**

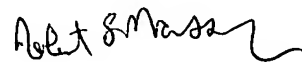
4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Navin Natnithithadha whose telephone number is (571) 272-4732. The examiner can normally be reached on Monday-Friday, 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571) 272-4726. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Navin Natnithithadha  
Patent Examiner  
GAU 3736  
13 January 2006



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